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1772

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

May 16, 2005

Application Number: 09/775,451
Filing Date: February 01, 2001
Appellant(s): LINCECUM, HOWARD LYNN

Lance A. Foster
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

This Supplemental Examiner's Answer was ordered by the Board of Patent Appeals and Interferences in an Order Returning Undocketed Appeal to Examiner mailed May 6, 2005.

This is in response to the appeal brief filed September 24, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

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(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct. Note that the Final Office Action was mailed March 31, 2003, not January 31, 2003 as is stated in Appellant's statement of the status of the claims in the brief.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct except for the following items: Examiner wishes to point out that claim 4 limits the invention to a polyethylene material, and not the broader genus of polymer as Appellant states at the bottom of page 2 of the brief, that claim 11 is not a "use claim" as Appellant's summary of claim 11 on page 3 of the brief suggests and that claim 11 is not dependent upon claim 1 as Appellant's summary of claim 11 suggests.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because Sugimoto et al. teaches that furniture is an article that the packaging is

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used to protect (col. 7, lines 3-10 of Sugimoto et al. and claim 1 of Sugimoto et al.); the rejection of claims 1-4, 6-8 and 11 addresses claims 1-4, 6-8 and 11 together, and therefore, claims 1-4, 6-8, 11, 18 and 19 should stand or fall together. Appellant's statement on page 17 of the brief "In the First Office Action (Paper #6) and Final Office Action (Paper #10), the examiner's rejection of claim 11 was supported by the same reasons used to support rejections of claims 1-4, 6-8, 18 and 19." supports Examiner's position that claims 1-4, 6-8, 11, 18 and 19 should stand or fall together. Appellant follows this statement by stating the differences between claim 11 and the other claims; however, 37 CFR 1.192(c)(7) states "Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable". 37 CFR 1.192(c)(7) requires that appellant explain "why the claims of the group are believed to be separately patentable" for more than one group of claims to be considered on appeal; Appellant has not explained why claim 11 is believed to be separately patentable over claims 1-4, 6-8, 18 and 19. Note that on page 18 of the brief, Appellant states that "claim 11 more clearly defines that the low coefficient of friction layer is the layer in contact with the furniture", but claim 11 does not recite that the bag is in contact with the article of furniture as claimed.

(8) *Claims Appealed*

A substantially correct copy of appealed claims 1-4, 6-8, 11, 18 and 19 appears on pages 1-2 of the Appendix to the appellant's brief. The differences between the claims provided in the Appendix of the brief and in the claims presented in the After Final Amendment (Paper 14) are as follows: the word "and" was added after "0.275;" in claim 1, the word "and" after "0.250;" in claim 8 was removed and the word "and" was added after "furniture;" in the second line of claim 11.

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(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

U.S. 4,856,656

Sugimoto et al.

8-1989

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

Claims 1-4, 6-8, 11, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugimoto et al.

Sugimoto et al. teaches a multilayer film which comprises three resin layers for a package including a low density polyethylene-based resin layer and a high density polyethylene-based resin layer (col. 2, lines 47-53 and claim 1). The film can be used as a bag (col. 2, lines 16-17). The low density polyethylene-based resin layer (LDPE layer) is the inner layer, which is in contact with the article to be packaged, and has a coefficient of static friction of not less than 0.4 (col. 3, lines 34-45). The high density polyethylene-based resin layer (HDPE layer) is the outer layer and has a coefficient of static friction which is not more than 0.35 (col. 4, lines 51-67). The LDPE layer has a density in the range of 0.900-0.940g/cc (col. 2, lines 54-56) and the HDPE layer has a density in the range of 0.945-0.975g/cc (col. 4, lines 37-39). The invention comprises the multi-layer film and an article to be packaged (col. 6, lines 7-9). Furniture is disclosed as an article that the packaging can be used to protect (col. 7, lines 3-10 and claim 1). The fact that low density polyethylene-based resins have a higher coefficient of friction than high density polyethylene-based resins is clearly established by Sugimoto et al. wherein it is stated that the

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low density polyethylene-based resin layer imparts anti-slipperiness and flexibility to the multi-layer film (col. 3, lines 29-31) and that the high density polyethylene-based resin layer imparts slipperiness, strength and stiffness to the multi-layer film (col. 4, lines 51-53).

Sugimoto et al. fails to teach that the outer layer has a higher coefficient of friction and a lower density than the inner layer; i.e., the inner and outer layers of Sugimoto et al. are arranged opposite to the arrangement of the instant application with respect to coefficient of friction and density. Sugimoto et al. do teach that since the outer layer (C) has a lower coefficient of friction than the inner layer, the buffering material (see col. 6, lines 7-9 and item 4 in Figure 1) easily slips over the packaging film (col. 6, lines 38-43). The aim of achieving easy slippage between the surfaces of two articles (i.e., the respective surfaces of the bag and the packaging material) is thus clearly established by Sugimoto et al. Whereas Sugimoto et al. aims for easy slippage between the outer surface of the bag and the buffering material to achieve easy removal of the buffering material from the film packaging an article or to achieve easy placement of the buffering material on the film packaging an article, the applicant of the instant application aims for easy slippage between the inner surface of the bag and the article to be packaged. Therefore, the instant application applies the notoriously well known practice of achieving easy slippage between a surface of a bag and a surface of an article via tailoring coefficient of friction of the bag in order to achieve easy removal/placement of an article from/in the bag. The applicant applies this notoriously well known practice to a product with a different intended end-use.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have switched the outer and inner layers in the film for packaging of Sugimoto et al., depending on the end-use of the product, in order to produce a bag with an outer

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layer with a higher coefficient of friction and a lower density than the inner layer so that an article can easily be removed from or placed in the bag, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

In regard to claim 8, the impact strength of the multi-layer film is addressed by Sugimoto et al. The impact strengths of example films are given in Table 1, col. 9 and are reported in units of kg*cm. While the impact strengths cannot be readily compared between Sugimoto et al. and claim 8 of the instant application, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have developed a polyethylene-based film intended to be utilized as the middle layer of the three layer film of Sugimoto et al. with a Dart Impact strength of approximately 95 g/mil, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art in absence of unexpected results. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). In regard to claims 18 and 19, Sugimoto et al. teach the bag as discussed above. In regard to the claimed dart impact strength range of between approximately 70 and 200 grams per mil, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a middle polymer film layer that has a dart impact strength of between approximately 70 and 200 grams per mil depending on the particular desired end result, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art in the absence of unexpected results. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

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(11) *Response to Argument*

Appellant's arguments on pages 8-17 of the brief (Paper 16) regarding the 35 U.S.C. 103 rejection of claims 1-4, 6-8, 11, 18 and 19 over Sugimoto et al. have been fully considered but they are not persuasive

In response to Appellant's argument on page 8 of the brief that "reversing the layers of the multilayered film", as the rejection proposes, "neglectfully ignores the purpose and function behind the design of [Sugimoto et al. and Appellant's invention]", whereas Sugimoto et al. aims for easy slippage between the outer surface of the bag and the buffering material to achieve easy removal of the buffering material from the film packaging an article or to achieve easy placement of the buffering material on the film packaging an article, the applicant of the instant application aims for easy slippage between the inner surface of the bag and the article to be packaged. Therefore, the instant application applies the notoriously well known practice of achieving easy slippage between a surface of a bag and a surface of an article via tailoring coefficient of friction of the bag in order to achieve easy removal/placement of an article from/in the bag. The applicant applies this notoriously well known practice to a product with a different intended end-use. The "purpose and function behind the design of [Sugimoto et al. and Appellant's invention]" is certainly not "neglectfully ignore[d]" in the rejection. The "purpose and function" taught by Sugimoto et al. is achieving easy slippage between a surface of a bag and a surface of an article as identified in the 35 U.S.C. 103 rejection of claim 1 of record. While Sugimoto et al. applies this notoriously well known practice for the intended end result of easy slippage between the outer surface of the bag and the buffering material to achieve easy removal of the buffering material from the film packaging an article or to achieve easy placement of the

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buffering material on the film packaging an article, the instant application uses this same notoriously well known practice for the different intended end result of easy slippage between the inner surface of the bag and the article to be packaged. Therefore, it would have indeed been obvious to one having ordinary skill in the art at the time the invention was made to have switched the outer and inner layers in the film for packaging of Sugimoto et al., depending on the end-use (equivalently, the intended end result) of the product, in order to produce a bag with an outer layer with a higher coefficient of friction and a lower density than the inner layer so that an article can easily be removed from or placed in the bag as provided in the 35 U.S.C. 103 rejection of claim 1 of record.

Appellant asserts on page 8 of the brief that the three criteria for establishing a *prima facie* case of obviousness has not been met. The motivation to modify the reference criterion is discussed above and below. In regard to the reasonable expectation of success criterion, Sugimoto et al. establish that achieving easy slippage between a surface of a bag and a surface of an article is a notoriously well known practice as discussed in the 35 U.S.C. 103 rejection of claim 1 of record. Furthermore, Sugimoto et al. establish the achievement of easy slippage between a surface of a multilayer bag and a surface of an article and of grippage between the other surface of the multilayer bag and a surface of another article as a notoriously well known practice: the aim of both Sugimoto et al. and Applicant is to enable slippage between the bag and an article. In the case of Sugimoto et al., the coefficient of friction (COF) of the outer layer of the bag of Sugimoto et al. is low (lower than 0.35) to enable the bag to slip easily from the buffering material of Sugimoto et al. In the case of Applicant, the COF of the inner layer of the bag is low to enable the material to slip easily over the contents of the bag, as the specification of

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Applicant clearly establishes that it is important for the plastic layer of a bag that is in contact with furniture to have a low COF so that “the reduced COF of the bag material allows the bag to slip onto the furniture more easily” (page 2, lines 1-6). Therefore, Sugimoto et al. and Applicant are dealing with the same problem, i.e., the selection of a polymeric composition to be formed into a film that is in contact with an article to achieve a desired degree of slippage between the film and the article as quantified by the COF of the film. Therefore, one of ordinary skill in the art is indeed motivated to swap inner and outer layers in the film of Sugimoto et al. (which would entail merely flipping the bag of Sugimoto et al. inside-out) at least for the goal of achieving a low degree of slippage on the inside of the bag so that an article may easily slip along the inside of the bag as opposed to along the outside of the bag as taught by Sugimoto et al. Further motivation is derived from the fact that the both Sugimoto et al. and Applicant aim to achieve a desired degree of grippage with the layer on the side of the multilayer films of Sugimoto et al. and Applicant that is opposite the low COF layer. Sugimoto et al. therefore establish a reasonable expectation of success insofar as easy slippage between a surface of a multilayer bag and a surface of an article and of grippage between the other surface of the multilayer bag and a surface of another article is achieved via use of a multilayer bag having one surface layer having a relatively low coefficient of friction and one surface layer having a relatively high coefficient of friction as taught by Sugimoto et al. The desired results of slippage on one side of the multilayer bag and grippage on the other side of the multilayer bag are expected and predictable based on the teaching of Sugimoto et al., regardless of the arrangement of the layers. In regard to the “teach or suggest all the claim limitations” criterion, all the claim limitations are taught or suggested by Sugimoto et al.

Appellant argues on pages 9-13 of the brief that the proposed modification would render the invention unsatisfactory for its intended purpose. Appellant relies on the *In re Gordon* case cited in MPEP § 2143.01 in support of Appellant's argument as Appellant relied on the *Gordon* case in Paper 9, but whereas MPEP §2143.01 applies to devices that are used for entirely different purposes (i.e. blood filtering and removing gas and water from gasoline), Sugimoto et al. and Applicant actually share a common purpose. Sugimoto et al. and Applicant's purpose is to enable slippage between the bag and an article. Filtering blood and removing gas and water from gasoline are two completely different intended uses, which is demonstrated by the necessity to turn the gasoline filter over for use as a blood filter (Appellant states in lines 5-7 of page 17 of the brief "the court held that the prior art gasoline filter actually taught away from the structural design of the blood filter. Recall in that case the blood filter was oriented in an opposite fashion from the gasoline filter"), whereas enabling slippage between a bag and an article is the same intended use regardless of upon which surface of a multilayer bag (the inner or outer surface) slippage occurs. Contrary to Appellant's assertion at the top of page 10 of the brief, the facts in the instant case are not at all similar to the facts of *Gordon* as discussed above. Appellant then states "Similar to the facts in *Gordon*, the inner and outer layers of Applicant's claimed dual surface bag are oriented in an opposite fashion to that of the layers in the Sugimoto multilayer packaging". The "Similar to the facts in *Gordon*" statement is entirely incorrect; there is no multilayer bag having inner and outer layers in the *Gordon* case and there is no issue where layers of a multilayer film of the application "are oriented in an opposite fashion to that of those of the prior art (once again, there is no multilayer film involved in the *Gordon* case).

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In response to Appellant's argument on page 10 of the brief that the proposed modification of the Office Action "would defeat the intended functionality of the Sugimoto film", it is Examiner's position that Sugimoto et al. teach that the intended functionality of the film is the achievement of easy slippage between a surface of a bag and a surface of an article and of grippage between the other surface of the bag and a surface of another article. While Appellant argues that "the rubbing problem that Sugimoto was trying to solve would only be aggravated" and that "the buffer material would no longer easily slide over the article packaged in the Sugimoto film", these arguments are irrelevant because the use of the bag to hold an article where the bag does not cause rub damage to the article and the use of the bag with buffer material are intended uses of Sugimoto et al.; it has been held that a recitation with respect to the manner in which a claimed article is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQd 1647 (1987). For the particular intended use of Applicant, one of ordinary skill in the art would have recognized to have modified the bag as proposed to achieve the same intended functionality of the film taught by Sugimoto et al., i.e. the achievement of easy slippage between a surface of a bag and a surface of an article and of grippage between the other surface of the bag and a surface of another article.

Appellant argues that "the Gordon court does not assign any weight to the fact that one filter is used to filter blood and the other for gasoline" and therefore, that Examiner's "distinction that the devices in Gordon are used for different purposes lacks merit"; however, the fact that the the prior art was for filtering gasoline and that the application was for filtering blood was necessarily a factor in the case since:

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The court reversed, finding that if the prior art device was turned upside down it would be inoperable for its intended purpose because the gasoline to be filtered would be trapped at the top, the water and heavier oils sought to be separated would flow out of the outlet instead of the purified gasoline, and the screen would become clogged.

The gasoline filter device had to be turned upside down so that it would have the structure of the claimed blood filter and so it would consequently function properly as a blood filter. The instant case does not involve fluids having different densities (e.g. blood and gasoline) that would determine whether or not a particular elevation of a device within a filter assembly would render the device functional. Turning the filtering device of the *Gordon* case upside down is a far different issue from flipping a multilayer bag inside out as in the instant application.

Appellant argues that “the desirability of the modification” is not suggested, but it is Examiner’s position that the clear establishment by Sugimoto et al. of the intended functionality of the film of the achievement of easy slippage between a surface of a bag and a surface of an article and of grippage between the other surface of the bag and a surface of another article provides one of ordinary skill in the art with the motivation (desirability) to make the proposed modification depending on the intended end result as discussed above. In response to Applicant’s argument that the Examiner’s conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the invention was made, and does not include knowledge gleaned only from the applicant’s disclosure, such a reconstruction is proper. *In re McLaughlin*, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971); the achievement of easy slippage between a surface of a bag and a surface of an article and of grippage between the other surface of the bag and a surface of another article is not knowledge

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gleaned only from the applicant's disclosure: Sugimoto et al. establish that this is a notoriously well known practice; the particular arrangement of the layers is a matter of the required arrangement for the particular desired end use.

Appellant argues that Examiner's reliance on *Ex parte Masham* is inappropriate. For clarification, the structural limitations to which Examiner refers are the structural limitations of the bag of Sugimoto et al. after the proposed modification is made. The goals of Sugimoto et al. to which Appellant referred, avoiding rub damage and avoiding difficulty of slippage of the buffering material, are particular intended uses taught by Sugimoto et al.

Appellant argues that the proposed modification of the bag of Sugimoto et al. "leads to a completely new operation of the invention" and therefore, *In re Japiske* is not applicable. However, it is Examiner's position that the operation of the invention is the same in that easy slippage between a surface of a bag and a surface of an article and grippage between the other surface of the bag and a surface of another article as taught by Sugimoto et al. is achieved by the modified bag of Sugimoto et al. as proposed by Examiner. Since operation of the invention was not modified by the proposed modification, reliance on *In re Japiske* is appropriate.

In response to Appellant's arguments on pages 15-16 of the brief, it is Examiner's position that the operation of the invention is the same in that easy slippage between a surface of a bag and a surface of an article and grippage between the other surface of the bag and a surface of another article as taught by Sugimoto et al. is achieved by the modified bag of Sugimoto et al. as proposed by Examiner. Furthermore, while Appellant argues that "the rubbing problem that Sugimoto was trying to solve would only be aggravated" and that "the buffer material would no longer easily slide over the article packaged in the Sugimoto film", these arguments are

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irrelevant because the use of the bag to hold an article where the bag does not cause rub damage to the article and the use of the bag with buffer material are intended uses of Sugimoto et al.

In response to Appellant's argument on page 17 of the brief that Sugimoto et al. teaches away from the proposed modification, it is Examiner's position that Sugimoto et al. teach the achievement of easy slippage between a surface of a bag and a surface of an article and of grippage between the other surface of the bag and a surface of another article. This teaching is in no way contrary to the proposed modification.

Therefore, Examiner respectfully submits that claims 1-4, 6-8, 11, 18 and 19 should be rejected since the scope of the claims falls within the limitations of the existing art. Thus, after considering all the evidence, it is still the position of Examiner that the rejection is appropriate.

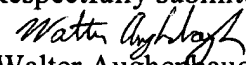
For the above reasons, it is believed that the rejections should be sustained.

Conferees:

Deborah Jones 

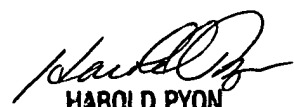
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May 16, 2005

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